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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,814

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Hideki Ishihara

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EXAMINER

DOUYON, LORNA M

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

10/26/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/523,814	Applicant(s) ISHIHARA ET AL.	
	Examiner Lorna M. Douyon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/21/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 11, 2009 has been entered.
2. Claims 2-10 are pending. Claim 1 is cancelled. Claims 3-5 are withdrawn from further consideration as being drawn to a nonelected invention. Claims 6-8 are amended. Claims 9-10 are newly added.
3. The objection to claims 7-8 are for minor informalities is withdrawn in view of Applicants' amendment.
4. The rejection of claims 2, 6-8 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is withdrawn in view of Applicants' amendment.
5. The rejection of claims 6-8 under 35 U.S.C. 103(a) as being unpatentable over Yorozu et al. (US Patent No. 5,141,666), hereinafter "Yorozu" in view of Rau (US Patent No. 6,121,215) is withdrawn in view of Applicants' amendment.

6. The rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Yorozu and Rau as applied to the above claims, and further in view of Nakatsu et al. (US Patent No. 5,965,518) is withdrawn in view of Applicants' amendment.

Claim Objections

7. Claims 6 and 10 are objected to because of the following informalities:
- i) in claim 6, line 19, the comma after "benzyl" should be deleted so that it would read as "benzyl isovalerate" (support of which is found on page 18, line 17),
 - ii) in claim 10, line 13, "undecalacton;," is not presented properly (i.e., the term is misspelled and there are two punctuation marks).
- Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 2, 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trinh et al. (US Patent No. 5,849,310), hereinafter "Trinh".

Trinh teaches a personal cleansing composition comprising (A) from about 0.001% to about 10% by weight of an enduring perfume composition comprising at least

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70% of enduring perfume ingredients; (b) from about 0.01% to about 95% by weight of a detergent surfactant system; and (C) the balance comprising carrier, wherein the pH is from about 4 to about 11 (see claim 1). Examples of enduring perfume, among others, include para-tert-butylcyclohexyl acetate (reads on component B(ii)), (see col. 2, lines 15-16; col. 3, lines 12-13), ambrettolide (a musk) (reads on component A), iso-amyl salicylate (reads on component B(i)), beta-caryophyllene (reads on component C), galaxolide (reads on component A), hexadecanolide (reads on component A), phenyl ethyl benzoate (reads on component B(i)), dodecalactone, delta-undecalactone, gamma-undecalactone, (all 3 read on component B(iii)), see Table 1 under cols. 5-6. Another perfume is d-limonene (see Table 2, col. 7, line 24). The surfactant system includes anionic surfactants, nonionic surfactants, cationic surfactants, amphoteric surfactants, zwitterionic surfactants, and mixtures thereof (see col. 7, lines 30-55). Examples of anionic surfactants include soaps and alkyl sulfate (see col. 8, lines 1-18). The personal cleansing compositions are normally rinsed, like shampoos and personal skin cleansers (see col. 15, lines 14-16). The shampoo composition typically contains from about 1% to about 30% by weight of the surfactant system (see col. 15, lines 28-35), and typically comprise from about 40% to about 89% by weight of water (see col. 21, lines 25-29). The pH of the shampoo compositions is not generally critical and can be in the range of from 2 to about 10, preferably from about 3 to about 9, more preferably from about 4 to about 8 (see col. 21, lines 29-33). The composition will optionally comprise from about 0.05% to about 10% of non-volatile, fluid hair conditioning agent (see col. 21, lines 34-39), like silicone oil (see col. 2, lines 43-53) and light mineral oil,

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for example, 0.5 wt% (see Ingredient 1 in the Table under col. 53). The compositions can also contain one or more humectant or moisturizing materials at a level from about 0.1% to about 20%, more preferably from about 1% to about 10% and most preferably from about 2% to about 5%, which includes lactic acid and lactate salts (see col. 44, lines 23-32). Additional components for hair care compositions include anti-dandruff actives such as selenium disulfide or sulfur (see col. 46, lines 15-19) (which reads on claim 2). Trinh, however, fails to specifically disclose a personal treatment or shampoo composition comprising a fragrance composition which comprises at least one musk; iso-amyl salicylate and/or phenyl ethyl benzoate; ortho-tert-butylcyclohexyl acetate; dodecalactone, delta-undecalactone, and/or gamma-undecalactone; and beta-caryophyllene and/or d-limonene.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared a personal personal treatment or shampoo composition comprising a fragrance composition which comprises at least one musk; iso-amyl salicylate and/or phenyl ethyl benzoate; ortho-tert-butylcyclohexyl acetate; dodecalactone, delta-undecalactone, and/or gamma-undecalactone; and beta-caryophyllene and/or d-limonene because Trinh specifically desires mixtures of perfume ingredients and these are some of the suitable selection of perfume ingredients which provides a long lasting aesthetic benefit and which are relatively non-irritation as disclosed in col. 1, lines 58-62. With respect to ortho-tert-butylcyclohexyl acetate, please note that structurally similar compounds (i.e., para-tert-butylcyclohexyl acetate and ortho-tert-butylcyclohexyl acetate) are generally expected to have similar

properties, *In re Gvurik*, 596 F. 2d 1012, 201 USPQ 552. Closely related homologues, analogs and isomers in chemistry may create a *prima facie* case of obviousness, *In re Dillon* USPQ 2d 1 897, 1904 (Fed. Cir. 1990); *In re Payne* 203 USPQ 245 (CCPA 1979); *In re Mills* 126 USPQ 5 13 (CCPA 1960); *In re Henze* 85 USPQ 261 (CCPA 1950); *In re Hass* 60 USPQ 544 (CCPA 1944).

10. Claims 2, 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. (US 2003/0216283), hereinafter "Ishida" in view of Trinh.

Ishida teaches a fragrance composition having high fragrance properties which is useful in various fragrance providing products such as cosmetics, toiletry products, bath compositions and pharmaceuticals (see abstract), and is present in said products in an amount from 0.01 to 50 wt% by weight (see claim 4). The fragrance composition contains a glycerol ether derivative as an essential component and can further comprise other fragrance components commonly employed in the art in appropriate combination, such as ketones, aldehydes esters, alcohols, ethers, terpenes, natural essential oils, and synthetic musk (see paragraph [0037] on page 3). Typical fragrances useful in the invention include ambrettolide (a musk), galaxolide (another musk), musk TM-II (all 3 read on component A), p-t-butylcyclohexyl acetate (reads on component B(ii)), γ -C₆-C₁₃ lactone (reads on component B(iii)), limonene (reads on component C), methyl salicylate (reads on component B(i)), α -pinene (also reads on component C), see paragraph [0039] on page 4. The products to which the fragrance composition is applied may contain arbitrary components such as fats and oils, anionic surfactants and pH

adjustors (see paragraph [0040] on page 4). The oils include avocado oil, camellia oil, turtle oil, etc. (see paragraph [0043] on page 5). For example, oil like jojoba oil is used at 2.50 wt% (see Example 9, paragraph [0110] on page 12). The anionic surfactants include fatty acids soaps, higher alkylsulfuric ester salts, etc. (see paragraph [0050] on page 5). The pH adjustors include buffers such as lactic acid-sodium lactate and citric acid-sodium citrate (see paragraph [0072] on page 7). The dermatological preparation may be in a unit dose form and is formulated as a solution form, an emulsion form, a gel form or a water/oil two-layer form (see paragraph [0075] on page 7). In Example 6, a shampoo formulation comprises 14.0 wt% sodium polyoxyethylene-lauryl-ether-sulfate anionic surfactant, a proper amount of citric acid (which is equivalent to lactic acid), 0.50 wt% fragrance composition and balance water (see paragraph [0096] on page 10). Ishida, however, fails to specifically disclose a cosmetic or shampoo formulation comprising a fragrance composition which comprises at least one musk like ambrettolide or galaxolide; o-t-butylcyclohexyl acetate, γ -C₈-C₁₂; limonene or α -pinene; and methyl salicylate; a sulfur-containing compound; and the pH of the formulation.

Trinh teaches the features as described above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared a personal personal treatment or shampoo composition comprising a cosmetic or shampoo formulation comprising a fragrance composition which comprises at least one musk like ambrettolide or galaxolide; o-t-butylcyclohexyl acetate, γ -C₈-C₁₂; limonene or α -pinene; and methyl salicylate because the teachings of Ishida encompass the mixtures of these perfume ingredients. With

respect to o-t-butylcyclohexyl acetate, please note that structurally similar compounds (i.e., p-t-butylcyclohexyl acetate and o-t-butylcyclohexyl acetate) are generally expected to have similar properties, *In re Gvurik*, 596 F. 2d 1012, 201 USPQ 552. Closely related homologues, analogs and isomers in chemistry may create a *prima facie* case of obviousness, *In re Dillon* USPQ 2d 1897, 1904 (Fed. Cir. 1990); *In re Payne* 203 USPQ 245 (CCPA 1979); *In re Mills* 126 USPQ 5 13 (CCPA 1960); *In re Henze* 85 USPQ 261 (CCPA 1950); *In re Hass* 60 USPQ 544 (CCPA 1944).

It would also have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the selenium disulfide or sulfur anti-dandruff actives of Trinh into the composition of Ishida because this would provide anti-dandruff properties as taught by Trinh.

It would also have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared the formulation of Ishida having a pH from 2 to about 5, because it is known from Trinh that similar products are prepared with this pH range.

Response to Arguments

11. Applicants' arguments with respect to claims 2, 6-8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/
Primary Examiner, Art Unit 1796